

REMARKS

Upon entry of this Amendment, claims 1-29 will remain pending and under current examination. By this Amendment, Applicants present new claims 22-29 for examination.

In the Office Action,¹ the Examiner rejected claims 1-21 under 35 U.S.C. § 112, second paragraph; rejected claims 1-8 and 14-21 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,993,505 to Katz et al. ("Katz"); and rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Katz.

Applicants thank the Examiner for conducting an interview with Applicants' representative on June 1, 2006. The substance of the interview is incorporated into the foregoing amendments and the following remarks.

New claims 22-29, although of different scope, recite similar elements to claims 10-13. Applicants respectfully submit that new claims 22-29 are allowable for at least the reasons discussed below regarding claims 10-13.

Applicants respectfully traverse the Examiner's rejections for the following reasons.

I. Regarding the rejection of claims 1-21 under 35 U.S.C. § 112, second paragraph.

In the Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph as indefinite because "the claim fails to clearly identify the purpose of the step 'evaluating the loan information', because the remaining steps 'identifying one

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

or more rules', 'retrieving stored loan information' and 'transforming the retrieved information' can be performed without performing the evaluation step." Office Action at p. 2.

By this Amendment, Applicants amend claim to improve form and obviate the Examiner's rejection. As discussed in the interview and recited by claim 1, the steps of "identifying," "retrieving," and "transforming" occur when "at least one of the one or more triggers is satisfied." In order to identify if triggers are satisfied, the loan information may be evaluated. Accordingly, as suggested by the Examiner in the interview, this Amendment clarifies the claim 1 step of "evaluating," rendering claim 1 definite.

Further, the Examiner rejected claim 1 as indefinite for failing "to specify what the output is." Id. As discussed in the interview, M.P.E.P. § 2173.04 instructs: "Breadth of a claim is not to be equated with indefiniteness." Applicants respectfully submit that recitation of "an output" in claim 1 is clear and therefore definite.

Moreover, the Examiner rejected claim 1 as indefinite because "one of ordinary skill in the art cannot ascertain how the step of transformation is relevant to the loan information." Office Action at p. 3. As recited by claim 1, "the retrieved information" may be formed from "retrieving the stored loan information from at least one of the one or more staging tables." The "retrieved information" may then be transformed "into one or more outputs based on at least one of the one or more rules." Because claim 1 sets forth this relationship between the loan information, the retrieved information, and the transformation, Applicants respectfully submit that claim 1 is definite.

Amended independent claims 14, 19, 20, and 21, although of different scope, recite elements similar to those of claim 1. Claims 2-9 and 15-18 depend from independent claims 1 and 14, respectively, and therefore include all of the elements recited therein. Accordingly, for at least the reasons discussed above with respect to claim 1, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-9 and 14-21 under 35 U.S.C. § 112, second paragraph.

In the Office Action, the Examiner also rejected claims 10-13 as allegedly indefinite, asserting: "Since the transformation of the retrieved loan information is based on 'one or more rules', the transformation does not depend on any relationship (or sequencing) amongst the rules them selves." Id. By this Amendment, Applicants place claim 10 in independent form and clarify that the transforming occurs "based on at least one of the one or more sequenced rules," as suggested by the Examiner. Accordingly, Applicants respectfully submit that independent claim 10 and dependent claims 11-13 are definite. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 10-13 under 35 U.S.C. § 112, second paragraph.

II. Regarding the rejection of claims 1-8 and 14-21 under 35 U.S.C. § 102(e) as being anticipated by Katz

Applicants respectfully traverse the rejection of claims 1-8 and 14-21 under 35 U.S.C. § 102(e) as being anticipated by Katz. In order to properly establish that Katz anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See

M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Katz does not disclose each and every element of Applicants' claimed invention.

Claim 1 calls for a combination including, for example,

evaluating the loan information stored in the one or more staging tables to identify one or more triggers that are satisfied based on one or more predetermined conditions;

identifying one or more rules, when at least one of the one or more triggers is satisfied;

retrieving stored loan information from at least one of the one or more staging tables to form retrieved information, when at least one of the one or more triggers is satisfied; and

transforming the retrieved information into one or more outputs based on at least one of the one or more rules.

The Examiner asserts that Katz discloses: "loan data is evaluated for CRA and HMDA compliance." Office Action at p. 4. The CRA and HDMA regulations "ensure fairness in lending by financial institutions." Katz, col. 1, line 22. Based on the Interview, the Examiner asserts that the claimed "triggers" are met by these CRA and HDMA regulations. The Examiner also asserts that the claimed "rules" are met by Katz's "CRA and HDMA (fair lending acts) requirements." Office Action at p. 4.

Applicants disagree with the foregoing assertions by the Examiner regarding Katz.

Even assuming that Katz's CRA and HDMA regulations constitute the claimed "triggers," which as noted above Applicants disagree that they do, Katz does not include any teaching or suggestion of identifying rules when the CRA and HDMA regulations are satisfied. Rather, Katz merely displays "reports relevant to the CRA and HMDA regulations ... to users to indicate the financial institution's performance relative to these statutes." Katz, col. 7, lines 56-58. Displaying reports relevant to CRA regulations

(alleged triggers), as taught by Katz, does not constitute a teaching or suggestion of identifying “one or more rules, when at least one of the one or more triggers is satisfied.”

Moreover, because Katz fails to teach or suggest “identifying one or more rules, when at least one of the one or more triggers is satisfied,” Katz cannot teach or suggest “transforming the retrieved information into one or more outputs based on ... the one or more rules,” as recited by claim 1.

Accordingly, Katz cannot anticipate claim 1 or dependent claims 2-8. Independent claims 14, 19, 20, and 21, although of different scope, recite elements similar to those of claim 1. Claim 14, claims 15-18, by the reason of dependency of claim 14, and claims 19-21 are therefore allowable for at least the reasons discussed above with respect to claim 1. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-8 and 14-21 under 35 U.S.C. § 102(e) as being anticipated by Katz.

III. Regarding the rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Katz.

Applicants respectfully submit that a prima facie case of obviousness has not been established with respect to claim 9. Claim 9 depends from independent claim 1 and therefore includes all of the elements recited therein. As discussed above, Katz fails to teach or suggest at least the claimed “identifying one or more rules” and “transforming” as recited by claim 1. The Examiner’s Official Notice that financial events “are old and well known” fails to cure these deficiencies. Office Action at pp. 5-6.

Because neither Katz nor the Examiner’s Official Notice teaches or suggests each and every element required by dependent claim 9, no prima facie case of

obviousness has been established with respect to this claim. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Katz.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

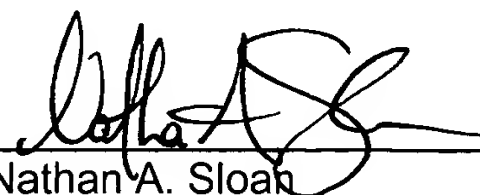
Should the Examiner continue to dispute the patentability of the claims after consideration of this Reply, Applicants encourage the Examiner to contact Applicants' undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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